

REMARKS

Review and reconsideration on the merits are requested.

First, Applicants would like to thank the Examiner for agreeing to a telephone interview concerning this application on March 22, 2005. The undersigned will contact the Examiner on that date.

At page 2 of the Action, the Examiner states:

“Applicants argue for synergy but this is not claimed and the argument for a method of plant protection does not negate Nasu/Collins; both protect and provide healthier plants.”

With respect to the first point, Applicants now insert a limitation regarding synergy into the claim fairly based upon the specification at page 5, lines 4-10.

If the Examiner believes that some other language would be more appropriate, Applicants would like to discuss this matter with the Examiner during the above mentioned telephone interview.

Applicants also amend claim 1 to call for the weight ratio of the imidazole compound to the inorganic phosphorus compound. Basis occurs in the specification at page 43, first full paragraph. As a consequence of including the weight ratio limit of claim 5 into claim 1, claim 5 is canceled.

Applicants next address the Examiner’s position at page 2 of the Action to the effect that:

“However, no great patentable weight is given to the argued for method insertion into claim 1, as this claim is a composition claim.”

Applicants believe that the Examiner must be referring to the limitation “which composition has curative and/or preventive effects on plant diseases, and is useful in agriculture and horticulture.

Splitting this limitation into two limitations, Applicants assume *arguendo* that “is useful in agriculture and horticulture” would, in fact, be considered either a “use” or “method”-type limit, and agree with the Examiner that, generally speaking, no great patentable weight should be given to set your limitation if it occurs in a composition claim.

However, Applicants believe it proper to treat “which composition has curative and/or preventive synergistic effects on plant diseases” as a true limitation on the composition, i.e., curative and/or preventive synergistic effects might be analogized to “antibiotic effects”, which clearly sets the essence of the invention and would not be considered a “method” insertion.

The Examiner is respectfully requested to reconsider on this point and to attach full weight to the “curative and/or preventive synergistic effects on plant diseases” limitation in claim 1.

Applicants now address the rejection of claims 1 and 4 (claim 5 has now been inserted into claim 1) as unpatentable over Nasu in view of Collins.

Applicants first focus on Collins since the Examiner relies upon Collins as disclosing the use of inorganic phosphorus compounds with added pesticides, concluding that it would be obvious to combine the Collins “inorganic phosphorus compounds” with the Nasu imidazole. The Examiner stating in the Action of April 19, 2004 at page 2:

“Motivation to combine is taught by in order to enhance efficacy and reduce Imidazole amount required.”

Applicants submit that the basis for motivation that the Examiner has urged is flawed. Specifically, **on this record**:

There is no suggestion that the combination of materials of Nasu and Collins would enhance sufficiency; nor

Is there any suggestion that the combination of Nasu with Collins would reduce the amount of imidazole compound required in Nasu.

Turning first to Collins at column 12, specifically beginning at about line 23, Collins states:

“Compositions containing compounds of general formula (I) *“which may be applied to control arthropod pests, may also contain synergists...”*”

Collins then proceeds to list specific compounds and classes of compounds including stabilizing substances, other insecticides, acaricides, plant nematocides, fungicides (2 examples), bactericides, arthropod attractants or repellents or pheromones, etc.

Collins really provides no definition as to what is meant by “synergists” in the context of Collins, but at best this seems to be an invitation to experiment in Collins unless a specific material is identified, since Collins indicates that these (apparently referring to the compounds and classes of materials in Collins) “**may be designed** to improve potency, persistence, safety, uptake where desired, spectrum of pests controlled or to enable the composition to perform other useful functions in the same animal or area treated.”

Beyond the above teaching, Collins literally contains no relevant teaching to one of ordinary skill in the art.

Importantly, however, after listing the **synergists**, Collins then turns to what seems to be considered by Collins a different class of materials, namely:

“Examples of pesticidally-active compounds” which may be included in, or used in conjunction with the compositions of the present invention are: [whereafter Collins lists materials].

Thus, rather than teaching that the “other pesticidally-active compounds” would enhance efficacy, Collins teaches against enhancing efficacy since the “other pesticidally-active compounds” are specifically not exemplified as “synergists” at column 12 of Collins.

Thus, Applicants respectfully submit that one predicate of the Examiner’s rejection is lacking.

Applicants now turn to the second basis for motivation urged by the Examiner, namely reducing the amount of imidazole compound required.

It is believed that by this the Examiner means that one of ordinary skill in the art would be motivated to use the Collins inorganic phosphorus compounds so that for some reason the amount of imidazole compound required in Nasu would be reduced.

Collins, of course, is rather specific to controlling arthropod pests, including insects and arachnids. While Collins may contain broader language, as is not unusual in an issued patent, Collins certainly does suggest to one of ordinary skill in the art that compounds such as fosetyl A1 shows many different type of activities which are, essentially, unpredictable. For example, in one instance apparently the art discovered that while Collins-type compounds were active ingredients effective against plant fungal diseases, it was unexpectedly found to be active against plant bacterial diseases which differ significantly from fungal diseases in their causes and

especially in their difficulty of control. Collins expands upon the rather unpredictable nature of the fosetyl-A1 type compounds at column 1, beginning about line 45, stating that while such compounds have been in commercial use as a fungicide treatment, it was not recognized or suggested that the same would have any significant or practical use against arthropod pests, especially insects. Thus, at least insofar as the fosetyl-A1 type materials of Collins are concerned, Collins itself attaches unpredictability to uses.

Against such background, it is appropriate to consider whether Nasu or Collins contain any suggestion that the Collins fosetyl-A1 type compounds would permit the imidazole compounds of Nasu to be used in lesser amounts (to use the Examiner's language "reduced Imidazole amount required.").

Applicants submit that such motivation with a reasonable expectation of reducing the imidazole amount of Nasu is nowhere suggested in the prior art relied upon. Collins has been above discussed. Applicants now turn to Nasu to see if there is any suggestion in Nasu that the amount of the Nasu imidazole compound required could be reduced by using **an inorganic phosphorus compound** in the sense of Collins.

As the following discussion will make clear, Nasu does not remedy the defects of Collins in this regard.

Nasu is a lengthy patent and the undersigned believes he has carefully reviewed Nasu for relevant disclosure. However, given the length of Nasu, the Examiner will no doubt wish to double check.

Referring to Nasu at column 44, about line 50 et seq., Nasu mentions excellent controlling effects against agriculturally and horticulturally harmful insects including, for example, spider mites.

Further, at column 44, about line 62 over to column 45, line 2, Nasu contains some introductory discussion about using the Nasu compounds in a variety of forms together with adjuvants as in conventional formulations. Beginning at column 45, at line 3 and continuing down to about line 63, Nasu discusses various adjuvants such as carriers, emulsifying agents, etc., weight ratios and application amounts.

At column 45, about line 64 over to about column 46, line 2, Nasu states:

“Further, if necessary and desired, the compound of the present invention can be used as admixture with or in combination with other agricultural chemicals, for example, insecticides, acaricides, nematocides, fungicides, antiviral agents, attractants, herbicides, plant growth regulators, etc. In this case, more excellent effects **can sometimes be exhibited.**”

Nasu, unfortunately, provides no suggestion of exactly what “excellent effects” would sometimes be exhibited nor does Nasu define what is meant by “can sometimes be exhibited.”, although given this phrase a common sense definition, it would be maybe sometimes excellent effects can be sometimes and maybe sometimes excellent effects cannot be obtained.

Perhaps more telling is the next paragraph in Nasu at column 46, about lines 3-13, which begins as follows:

“As the insecticides, acaricides or nematocides, mention may may be made of, for example, **organic phosphorus compounds...**”, Nasu continuing with a list which **nowhere suggests the use of inorganic phosphorus compounds as claimed herein.**

Note also Nasu at column 46, about line 14 et seq., where again **inorganic** phosphorus compounds **are not** mentioned.

While the Examples in Nasu are quite lengthy, it appears that FORMULATION EXAMPLES 7 and 8 are the only ones in Nasu that involve some type of phosphate, and the phosphate is a lower alcohol (organic) phosphate.

Nasu thus contains no suggestion that the amount of the Nasu imidazole could be reduced by using the Collins inorganic phosphorus compounds. In fact, Nasu conveys no suggestion that the Nasu compounds could be used with organic phosphorus compounds.

In short, Applicants respectfully submit that the motivation to combine Nasu and Collins comes from only one source: the present application. That is an improper basis for motivation and to support an obviousness rejection.

Considering all of the above, Applicants respectfully request withdrawal of the rejection of claims which would now be claims 1 and 4 over Nasu in view of Collins.

Assuming, however, that the Examiner has posed some type of minimal *prima facie* obviousness rejection, Applicants submit that the test results in the specification would rebut any such rejection (while Applicants appreciate there is either an obviousness rejection or there is not an obviousness rejection, it is not unreasonable to conclude that some obviousness rejections would be “stronger” than other obviousness rejection).

Specifically, the Examiner’s intention is directed to the discussion regarding the fact that where the incidence rate of a tested composition is lower than the theoretical one, the tested compound can be said to produce a synergistic effect. In such a case, the theoretical incidence

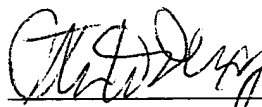
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rate (%) is shown in parentheses in Table 9. Referring to Table 9, it is easily seen from all instances the theoretical incidence rate when Compound No. 1 was used in combination with an Inorganic Phosphorus Compound, synergy was shown.

Referring now to Table 2 at page 61 of the specification, it is believed that a similar trend is established.

Withdrawal of the rejections and allowance is requested.

Respectfully submitted,



Peter D. Olexy, R.C.
Registration No. 24,513

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: March 22, 2005